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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,160	11/30/1999	STEVEN R. BOAL	15874-019001	8692
29989	7590	09/01/2009	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP			DURAN, ARTHUR D	
2055 GATEWAY PLACE				
SUITE 550			ART UNIT	PAPER NUMBER
SAN JOSE, CA 95110			3622	
			MAIL DATE	DELIVERY MODE
			09/01/2009	PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

2

3 BEFORE THE BOARD OF PATENT APPEALS
4 AND INTERFERENCES
5

6

7 Ex parte STEVEN R. BOAL
8

9

10 Appeal 2009-004910
11 Application 09/451,160
12 Technology Center 3600
13

14

15 Decided: August 31, 2009
16

17

18 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
19 ANTON W. FETTING, *Administrative Patent Judges*.
20

21 FETTING, *Administrative Patent Judge*.
22

23 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Steven R. Boal (Appellant) seeks review under 35 U.S.C. § 134 (2002)
3 of a final rejection of claims 1-18 and 22-50, the only claims pending in the
4 application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We AFFIRM.

9 THE INVENTION

10 The Appellant invented a system and method for electronic coupon
11 distribution. Specification 1:6-8.

12 An understanding of the invention can be derived from a reading of
13 exemplary claims 1, 24, and 26, which are reproduced below [bracketed
14 matter and some paragraphing added].

15 1. The method of claim 24 further including the steps of:

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed May 21, 2007) and Reply Brief ("Reply Br.," filed October 22, 2007), and the Examiner's Answer ("Ans.," mailed October 22, 2007), and Final Rejection ("Final Rej.," mailed October 4, 2006).

1 [1] collecting device information from a client system,
2 the device information being insufficient to specifically
3 identify the user;

4 [2] associating a device ID with the device
5 information at a main server system, the device ID being
6 insufficient to specifically identify the user;

7 [3] selecting said coupon according to the device ID to
8 thereby identify the coupon appropriate for said user
9 based on the device information; and,

10 [4] transmitting the selected coupon from the main
11 server system to the client system.

12

13 24. A method of secure electronic coupon distribution
14 comprising the steps of:

15 [1] receiving a coupon from a server;
16 [2] associating a Uniform Resource Locator (URL)
17 with the coupon, the URL containing a promotional code;
18 [3] invoking use of the URL with a browser to thereby
19 enable a user to redeem the coupon; and,
20 [4] disabling future use of the invoked URL.

21

22 26. A method of operating an electronic coupon distribution
23 system comprising the steps of:

24 [1] receiving a coupon request;
25 [2] collecting device information from a client system,
26 the device information being insufficient to specifically
27 identify a user of the client system;
28 [3] associating a device ID with the device
29 information at a main server system, the device ID being
30 insufficient to specifically identify the user;
31 [4] selecting a coupon according to the device ID to
32 thereby identify the coupon appropriate for said user
33 based on the device information; and

1 [5] transmitting the selected coupon from the main
2 server system to the client system.

3

4 THE REJECTIONS

5 The Examiner relies upon the following prior art:

Linden et al.	US 6,360,254 B1	Mar. 19, 2002
Barnett et al.	US 6,321,208 B1	Nov. 20, 2001
Lang	US 2003/0083931 A1	May 1, 2003

6

7 Claims 24-25 stand rejected under 35 U.S.C. § 103(a) as being
8 unpatentable over Linden and Barnett.

9 Claims 26-46 and 49-50 stand rejected under 35 U.S.C. § 103(a) as
10 being unpatentable over Lang and Barnett.

11 Claims 1-18, 22-23, and 47-48 stand rejected under 35 U.S.C. § 103(a)
12 as being unpatentable over Linden, Barnett, and Lang.

13

14 ARGUMENTS

15 *Claims 24-25 rejected under 35 U.S.C. § 103(a) as being unpatentable over*
16 *Linden and Barnett*

17 The Appellant argued these claims as a group.

18 Accordingly, we select claim 24 as representative of the group. 37
19 C.F.R. § 41.37(c)(1)(vii) (2008).

20 The Examiner found that Linden describes all of the limitations of claim
21 24, except for the step of a coupon request or receiving a coupon (Ans. 3-4).

1 The Examiner found that Barnett describes a coupon request. Ans. 4. The
2 Examiner found that a person with ordinary skill in the art would recognize
3 the benefit of facilitating promotions for goods and services to users by
4 receiving a coupon request. Ans. 4. The Examiner further found that a
5 person with ordinary skill in the art would have found it obvious to combine
6 Linden and Barnett. Ans. 4.

7 The Appellant contends that (1) Linden's gift certificate is not the same
8 as a coupon required by the claimed invention. App. Br. 4-5 and Reply Br.
9 2) and Linden and Barnett fail to describe limitation [1] of claim 24. (App.
10 Br. 5 and 7 and Reply Br. 3) and (2) Linden fails to describe limitation [2] of
11 claim 24. App. Br. 5-6 and Reply Br. 3.

12

13 *Claims 26-46 and 49-50 rejected under 35 U.S.C. § 103(a) as being*
14 *unpatentable over Lang and Barnett*

15 The Appellant argue these claims as a group.

16 Accordingly, we select claim 26 as representative of the group.

17 The Examiner found that Linden describes all of the limitations of claim
18 26, except for the step of a coupon request. Ans. 10. The Examiner found
19 that Barnett describes a coupon request. Ans. 11. The Examiner found that
20 a person with ordinary skill in the art would have recognized the benefit of
21 facilitating promotions for goods and services to users by receiving a coupon
22 request. Ans. 11. The Examiner further found that a person with ordinary
23 skill in the art would have found it obvious to combine Linden and Barnett.
24 Ans. 11.

1 The Appellant contends that (1) Lang and Barnett fail to describe the
2 device information being insufficient to specifically identify a user as
3 required by limitation [2] of claim 26 and claim 44 (App. Br. 7-10 and 12-13
4 and Reply Br. 4-5) and (2) Lang and Barnett fail to describe a coupon
5 request, selecting a coupon, and transmitting the selected coupon,
6 specifically because Lang fails to describe a coupon. App. Br. 10-12.

7

8 *Claims 1-18, 22-23, and 47-48 rejected under 35 U.S.C. § 103(a) as
9 being unpatentable over Linden, Barnett, and Lang*

10 The Appellant argue these claims as a group.

11 Accordingly, we select claim 1 as representative of the group.

12 The Examiner found that Linden and Barnett describe all of the
13 limitations of claim 24, but fail to describe targeting devices as required by
14 claim 1. Ans. 5. The Examiner found that although Lang does not describe
15 coupons, Lang does describe targeting devices, promotions, and all of the
16 additional limitations of claim 1. Ans. 5-6. The Examiner found that a
17 person with ordinary skill in the art would have recognized the benefit of
18 increasing sales by accurately targeting coupons based on available
19 information. Ans. 6. The Examiner further found that a person with
20 ordinary skill in the art would have found it obvious to combine Linden,
21 Barnett, and Lang. Ans. 6.

22 The Appellant contends that (1) claim 1 is allowable for the same
23 reasons as discussed for claim 24 (App. Br. 13) and (2) Lang fails to
24 describe the device being insufficient to specifically identify the user while
25 targeting users for advertisements, specifically because Lang can only target

1 users only after receiving personal information that identifies the user. App.
2 Br. 13.

3

4 ISSUES

5 The issues pertinent to this appeal are:

- 6 • Whether the Appellant has sustained their burden of showing that the
7 Examiner erred in rejecting claims 24-25 under 35 U.S.C. § 103(a) as
8 unpatentable over Linden and Barnett.
 - 9 ○ This pertinent issue turns on whether Linden and Barnett
10 describe receiving a coupon and associating a URL with the
11 coupon.
- 12 • Whether the Appellant has sustained their burden of showing that the
13 Examiner erred in rejecting claims 26-46 and 49-50 under 35 U.S.C. §
14 103(a) as unpatentable over Lang and Barnett.
 - 15 ○ This pertinent issue turns on whether Lang and Barnett describe
16 the device information is insufficient to identify a user.
- 17 • Whether the Appellant has sustained their burden of showing that the
18 Examiner erred in rejecting claims 1-18, 22-23, and 47-48 under 35
19 U.S.C. § 103(a) as unpatentable over Linden, Barnett, and Lang.
 - 20 ○ This pertinent issue turns on whether any of the arguments
21 *supra* are found persuasive.

FACTS PERTINENT TO THE ISSUES

2 The following enumerated Findings of Fact (FF) are believed to be
3 supported by a preponderance of the evidence.

4 *Facts Related to the Prior Art*

5 *Linden*

6 01. Linden is directed to a method for enabling users to efficiently
7 and securely access private Web pages and other types of
8 restricted resources. Linden 1:11-14.

9 02. Each private Web page is assigned a token character string
10 attached to the URL to identify the private page. Linden 1:60-
11 67. The allowable token space is sufficiently large such that the
12 probability that a random guess will produce a valid token is
13 very low. Linden 2:1-6. Authorized users are given the private
14 URL to access the private Web page. Linden 1:60-67. The
15 user enters the URL to the private Web page and the website
16 application server validates the token. Linden 2:21-25. This
17 provides a simple and efficient mechanism for allowing users to
18 access private resources while very little about the user is
19 known. Linden 2:33-40.

20 03. Practical applications of this method are for gift certificate and
21 coupon redemption. Linden 2:54-57. For example, a one-time
22 use URL to a private discount page can be emailed to a user
23 such that the user receives a discount on an item for purchase as
24 displayed on the target private web page. Linden 11:17-28.

1 *Barnett*

2 04. Barnett is directed to the interactive distributing of discount
3 coupons to remotely connected consumer computers and for
4 collecting user-specific data regarding coupon usage and user
5 demographic information from the remote computer. Barnett 1:6-
6 13.

7 05. The coupon data management program functions to request
8 coupon data from a centrally located repository, to store coupon
9 data transmitted from the repository, and to generate printable
10 coupon data from the stored coupon data. Barnett 4:52-57.

11 06. The user of the system can request coupon data to be
12 transmitted from the central repository and can instruct the remote
13 computer to print redemption coupons from the transmitted
14 coupon data. Barnett 5:1-6. The user can further select coupons
15 from the repository. Barnett 5:14-21. The system has data
16 exchange capabilities where data is sent from the central
17 repository to the remote computer used by the users. Barnett
18 5:22-34. The requested coupon data includes a fixed data
19 component and a variable data component. Barnett 5:6-13. The
20 fixed component is maintained on the remote computer, whereas
21 the variable component is transmitted from the central repository
22 to the remote computer upon the request for a coupon. Barnett
23 5:6-13.

24

25

1 *Lang*

2 07. *Lang* is directed to a method of targeted marketing for
3 consumers connected to a wide area network (WAN). *Lang* ¶
4 0003.

5 08. The first step of the method is to identify the electronic device
6 connected to the WAN by the device's numerical address or some
7 other identification information. *Lang* ¶ 0014. Next the physical
8 location of the device, using a GPS system or ground based
9 communication transmission system, is obtained. *Lang* ¶ 0015.
10 Then historical information, such as websites or files visited by
11 the device, is obtained. *Lang* ¶ 0016. The collected information
12 is used to create a user file and advertisements are transmitted to
13 the user's device based on the user file. *Lang* ¶ 0017. Additional
14 information can be added the user file, such as name, gender, age,
15 occupation, and marital status. *Lang* ¶ 0017.

16 *Facts Related To The Level Of Skill In The Art*

17 09. Neither the Examiner nor the Appellant has addressed the level
18 of ordinary skill in the pertinent arts of marketing systems and
19 electronic coupon distribution systems. We will therefore consider
20 the cited prior art as representative of the level of ordinary skill in
21 the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir.
22 2001) ("[T]he absence of specific findings on the level of skill in
23 the art does not give rise to reversible error 'where the prior art
24 itself reflects an appropriate level and a need for testimony is not

1 shown'') (quoting *Litton Indus. Prods., Inc. v. Solid State Sys.*
2 *Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

3 *Facts Related To Secondary Considerations*

4 10. There is no evidence on record of secondary considerations of
5 non-obviousness for our consideration.

6 PRINCIPLES OF LAW

7 *Obviousness*

8 A claimed invention is unpatentable if the differences between it and
9 the prior art are “such that the subject matter as a whole would have been
10 obvious at the time the invention was made to a person having ordinary skill
11 in the art.” 35 U.S.C. § 103(a) (2000). *KSR Int’l Co. v. Teleflex Inc.*, 550
12 U.S. 398, 406 (2007). *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

13 In *Graham*, the Court held that that the obviousness analysis is
14 bottomed on several basic factual inquiries: “[1] the scope and content of
15 the prior art are to be determined; [2] differences between the prior art and
16 the claims at issue are to be ascertained; and [3] the level of ordinary skill
17 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also, KSR*, 550
18 U.S. at 406. “The combination of familiar elements according to known
19 methods is likely to be obvious when it does no more than yield predictable
20 results.” *KSR*, 550 U.S. at 416.

21

22

1 ANALYSIS

2 *Claims 24-25 rejected under 35 U.S.C. § 103(a) as being unpatentable*
3 *over Linden and Barnett*

4 The Appellant first contends that (1) Linden's gift certificate is not the
5 same as a coupon required by the claimed invention (App. Br. 4-5 and Reply
6 Br. 2) and Linden and Barnett fails to describe limitation [1] of claim 24.
7 App. Br. 5, 7, and Reply Br. 3. We disagree with the Appellant. First,
8 limitation [1] of claim 24 requires the receiving of a coupon. Linden
9 describes a method that includes the step of emailing a URL to specific
10 private web pages to a user. FF 01-02. Linden further describes this method
11 to be used for distributing coupons, where the URL points to a specific
12 discount page. FF 03.

13 Although Linden does describe the method to be used for the distribution
14 gift certificates, Linden also explicitly describes the method to be used for
15 the distribution of coupons. Regardless, the Appellant's contention that
16 Linden fails to describe receiving a coupon from a server does not persuade
17 us of error on the part of the Examiner because the Examiner has relied on
18 Barnett to describe limitation [1]. As such, the Appellant is responding to
19 the rejection by attacking the references separately, even though the
20 rejection is based on the combined teachings of the references.
21 Nonobviousness cannot be established by attacking the references
22 individually when the rejection is predicated upon a combination of prior art
23 disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097(Fed. Cir.
24 1986).

1 Barnett describes a central repository for coupons and users can request
2 a coupon from the repository. FF 04-06). After the request for a coupon,
3 coupon data is transmitted from the central repository to the user's remote
4 computer. FF 06. That is, the user receives the coupon from the central
5 repository upon the request for a coupon. As such, Barnett does describe
6 receiving a coupon from a server, as required by limitation [1].

7 The Appellant additionally contends that (2) Linden fails to describe
8 limitation [2] of claim 24. App. Br. 5-6 and Reply Br. 3. We disagree with
9 the Appellant. Limitation [2] requires associating a uniform resource locator
10 (URL) with a coupon, where the URL contains a promotional code. Linden
11 explicitly describes a URL that directs a user to a private web page that
12 contains a coupon. FF 03. As such, the URL in Linden is associated to a
13 coupon. Furthermore, the URL contains a token that is validated by the
14 server before presenting the user with the private coupon. FF 02. That is,
15 the token is a code that is specific to a coupon. As such, Linden describes
16 all of the requirements of limitation [2].

17 The Appellant has not sustained the burden of showing that the
18 Examiner erred in rejecting claims 24-25 under 35 U.S.C. § 103(a) as being
19 unpatentable over Linden and Barnett.

20

21 *Claims 26-46 and 49-50 rejected under 35 U.S.C. § 103(a) as being*
22 *unpatentable over Lang and Barnett*

23 The Appellant first contends that (1) Lang and Barnett fail to describe
24 the device information being insufficient to specifically identify a user as
25 required by limitation [2] of claims 26 and 44. App. Br. 7-10, 12-13 and

1 Reply Br. 4-5. We disagree with the Appellant. Lang describes a targeted
2 marketing method that uses information that is specific to a user's device.
3 FF 07-08. Lang describes that additional information that further identifies a
4 user can be added to users files compiled for a device. FF 08. That is, the
5 targeted marketing method is fully enabled without the use of this user
6 identification information. The Appellant further contends that Lang
7 requires personal information because Lang requires that users enter
8 personal information to create an account and log on to the system. App. Br.
9 8-9. However, Lang explicitly describes tracking the device usage for the
10 targeting marketing as is required by claims 26 and 44. Furthermore, even if
11 personal information is entered to create an account in Lang, there is nothing
12 in Lang to suggest that the personal information entered to create an account
13 is used in selecting a coupon to be sent to a device.

14 The Appellant also contends that the Examiner's argument that this
15 identification information is optional fails because Lang's objectives
16 includes tracking websites and files visited by the customers and also
17 tracking the physical locations of the customers. App. Br. 11-12. However,
18 as discussed *supra*, Lang tracks the activity and physical location of the
19 device and not the users. FF 08. Lang specifically describes that
20 advertisements are targeted based on the electronic device's identification
21 information. FF 08. As such, the targeted marketing is directed towards the
22 collected information specific to a device and the identity of the person or
23 persons using the device can remain unknown.

24 The Appellant further contends that (2) Lang and Barnett fail to describe
25 a coupon request, selecting a coupon, and transmitting the selected coupon,

1 specifically because Lang fails to describe a coupon. App. Br. 10-12. We
2 disagree with the Appellant.

3 The Examiner has relied on Barnett to describe receiving a coupon and
4 we find that Barnett does describe receiving a coupon as discussed *supra*.
5 As such, the Appellant's contention that Lang fails to describe a coupon and
6 specifically receiving a coupon does not persuade us of error on the part of
7 the Examiner because the Appellant responds to the rejection by attacking
8 the references separately, even though the rejection is based on the
9 combined teachings of the references. Nonobviousness cannot be
10 established by attacking the references individually when the rejection is
11 predicated upon a combination of prior art disclosures. *Id.* Lang further
12 describes selecting an advertisement based on the activities associated with a
13 device and transmits an advertisement to the device. FF 08. As such, the
14 combination of Lang and Barnett describes the limitations of claim 26.

15 The Appellant has not sustained the burden of showing that the
16 Examiner erred in rejecting claims 26-46 and 49-50 under 35 U.S.C. §
17 103(a) as being unpatentable over Lang and Barnett.

18

19 *Claims 1-18, 22-23, and 47-48 rejected under 35 U.S.C. § 103(a) as*
20 *being unpatentable over Linden, Barnett, and Lang*

21 The Appellant contends that (1) claim 1 is allowable for the same
22 reasons as discussed for claim 24. App. Br. 13. The Appellant's arguments
23 in support of claim 24 were not found persuasive *supra* and are therefore not
24 found persuasive here as well.

1 The Appellant further contends that (2) Lang fail to describe the device
2 being insufficient to specifically identify the user while targeting users for
3 advertisements, specifically because Lang can only target users only after
4 receiving personal information that identifies the user. App. Br. 13. We
5 disagree with the Appellant. This argument was also not found to be
6 persuasive *supra* and as such is not found persuasive here as well.

7 The Appellant has not sustained the burden of showing that the
8 Examiner erred in rejecting claims 1-18, 22-23, and 47-48 under 35 U.S.C. §
9 103(a) as unpatentable over Linden, Barnett, and Lang.

10

CONCLUSIONS OF LAW

12 The Appellant has not sustained the burden of showing that the
13 Examiner erred in rejecting claims 24-25 under 35 U.S.C. § 103(a) as being
14 unpatentable over Linden and Barnett.

15 The Appellant has not sustained the burden of showing that the
16 Examiner erred in rejecting claims 26-46 and 49-50 under 35 U.S.C. §
17 103(a) as being unpatentable over Lang and Barnett.

18 The Appellant has not sustained the burden of showing that the
19 Examiner erred in rejecting claims 1-18, 22-23, and 47-48 under 35 U.S.C. §
20 103(a) as unpatentable over Linden, Barnett, and Lang.

21

DECISION

23 To summarize, our decision is as follows.

Appeal 2009-004910
Application 09/451,160

- 1 • The rejection of claims 24-25 under 35 U.S.C. § 103(a) as being
2 unpatentable over Linden and Barnett is sustained.
- 3 • The rejection of claims 26-46 and 49-50 under 35 U.S.C. § 103(a) as
4 being unpatentable over Lang and Barnett is sustained.
- 5 • The rejection of claims 1-18, 22-23, and 47-48 under 35 U.S.C. §
6 103(a) as unpatentable over Linden, Barnett, and Lang is sustained.

7
8 No time period for taking any subsequent action in connection with this
9 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

10

11 AFFIRMED

12

13

14

15 mev

16

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